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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,433	12/03/2003	Douglas J. Duchon	20144-500	5815

7590 12/28/2004

Attn: James W. Inskeep  
INSKEEP INTELLECTUAL PROPERTY GROUP, INC.  
Suite 205  
1225 W 190th Street  
Gardena, CA 90248

EXAMINER

DAHBOUR, FADI H

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/726,433

Applicant(s)

DUCHON ET AL

Examiner

Fadi H. Dahbour

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7,9,10,13,18 and 19 is/are rejected.
- 7) ☒ Claim(s) 2,5,8,11,12 and 14-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/10/04, 6/14/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.



## **DETAILED ACTION**

### ***Drawings***

1. The drawings filed on 12/03/03 are objected to, because the element numbers and the figure labels should be thicker and clearer.

Any corrected drawing sheets must be in compliance with 37 CFR 1.121(d). Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 4, 6, 7, 9, 10, 13, 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Neuwirth ('457).

Regarding claims 10, 13, 18-19, Neuwirth discloses an implant for changing the gynecological state of a female (Figs.1-8), comprising a presterilized substance (see "sterilized" in line 30 of col.10, also see "sterile" in line 57 of col.11), the substance configured for causing a tissue response in uterine tissue (see "applied to the tissue to be treated" in line 67 of col.6 and in line 1 of col.7, also see "react with the target tissue" in lines 52-53 of col.8, also see "tissues contacted...showed reaction" in lines 8-9 of col.11), the substance sized and shaped for sufficiently contacting uterine tissue (see "applied to the tissue to be treated" in line 67 of col.6 and in line 1 of col.7, also see Fig.1) such that the tissue response (see "react with the target tissue" in lines 52-53 of col.8, also see "tissues contacted...showed reaction" in lines 8-9 of col.11) causes gynecological change in the female (see "so as to treat menorrhagia...heavy menstrual bleeding" in lines 13-14 & 37 of col.1), wherein the presterilized substance is coated with an adhesion inducing substance (see "paste to remain in contact with the target tissue" in lines 5-6 of abstract), wherein the substance is sized and shaped so as to eliminate menorrhagia (see "so as to treat menorrhagia...heavy menstrual bleeding" in lines 13-14 & 37 of col.1), wherein the substance is sized and shaped so as to cause contraception in the uterus (see "sterilization" in line 40 of col.1).

Regarding claims 1, 3, 4, 6, 7, 9, Neuwirth discloses a method of changing a gynecological state of a female (Figs.1-8), comprising evaluating the condition of a uterus of the female (14 of Fig.1), introducing a presterilized implant into the uterus (see "sterilized" in line 30 of col.10, also see "sterile" in line 57 of col.11, also see Fig.1), contacting the implant with uterine tissue (see "applied to the tissue to be treated" in line

67 of col.6 and in line 1 of col.7) so as to induce a tissue response in the uterus (see "react with the target tissue" in lines 52-53 of col.8, also see "tissues contacted...showed reaction" in lines 8-9 of col.11), maintaining contact between the implant and the uterine tissue (see "to remain in contact with the target tissue" in lines 5-6 of abstract) for at least so long that the tissue response causes a changed gynecological condition in the female (see "so as to treat menorrhagia ...heavy menstrual bleeding" in lines 13-14 & 37 of col.1), wherein the contact between the implant and the uterine tissue is maintained (see "to remain in contact with the target tissue" in lines 5-6 of abstract) at least until contraception in the uterus is achieved (see "sterilization" in line 40 of col.1), wherein the contact between the implant and the uterine tissue is maintained (see "to remain in contact with the target tissue" in lines 5-6 of abstract) at least until menorrhagia has been substantially eliminated in the female (see "so as to treat menorrhagia...heavy menstrual bleeding" in lines 13-14 & 37 of col.1), wherein the presterilized implant is coated with an adhesion inducing substance (see "paste to remain in contact with the target tissue" in lines 5-6 of abstract), wherein the presterilized implant is coated with a biologic coating prior to introducing the implant into the uterus (see "non-toxic" in line 64 of col.3), wherein the presterilized implant is introduced through a catheter (see "catheter" in lines 31 & 32 of col.4).

***Allowable Subject Matter***

4. Claims 2, 5, 8, 11-12, 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Neuwirth ('492) is cited to show an intrauterine procedure.

Spinale et al, Cohn et al and Goldberg et al are cited to show adhesions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadi H. Dahbour whose telephone number is 571-272-4792. The examiner can normally be reached on M-F, 9am-5:30pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Fadi H. Dahbour  
Examiner  
Art Unit 3743